

REMARKS

Claims 1-4 are pending in the instant application. Claim 3 has been amended to correct a typographical error. Support can be found at least at page 11, line 19, through page 12, line 5. Applicants make these amendments without prejudice to pursuing the original subject matter of this application in a later filed application claiming benefit of the instant application, including without prejudice to any determination of equivalents of the claimed subject matter. Support for these amendments appears throughout the specification and claims as filed. No new matter is introduced by these amendments.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 3 is rejected, allegedly for being indefinite. Applicants traverse but have amended claim 3 to recite the phrase, “caused by,” to describe the arterial wall injury. Support can be found at least at page 11, line 19, through page 12, line 5. The rejection is thus obviated and Applicants request withdrawal of the rejection.

Rejection under 35 U.S.C. § 102(b)

Claims 1-4 are rejected as anticipated by Nishi et al. (US 4,857,542). It is alleged that Nishi discloses a method to treat or prevent circulatory disorder. Specifically, it is alleged that the prior art inherently possesses the therapeutic effect, in overlapping dosage amounts, as disclosed by Applicants.

Applicants disagree and respectfully traverse.

The instant invention describes a method for prevention and/or therapy of arterial wall injury using a pyrazolone derivative.

In contrast, Nishi et al., as understood by Applicants, disclose a method of treating circulatory disorders wherein the disorders are selected from a broad list [see column 9, line 52 to column 10, line 19], and include at least, various ischemic diseases or various diseases based thereon, cerebrovascular disorders such as cerebral infarction, cerebral apoplexy, etc., various

cerebral diseases such as vascular dementia, cerebrovascular tissue lesion, various heart diseases, cardiac insufficiency angina pectoris, etc., and various peripheral circulation disorders, etc.

The actual number of possible disorder or combinations of disorders is extremely large. Additionally, Nishi discloses 72 individual pyrazolone derivatives used to treat the extremely large number of possible disorders.

Applicants indicate that one of ordinary skill in the art would not envisage using a pyrazolone to prevent or provide therapy for an arterial wall injury, based on the laundry list of possibilities provided by Nishi. The MPEP states, in section 2131.02, that,

When the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. If one of ordinary skill in the art is able to “at once envisage” the specific compound within the generic chemical formula, the compound is anticipated.

Additionally, this concept is enunciated in *In re Petering* 301 F.2d 676, 133 USPQ 275 (CCPA 1962), where it was determined that that a generic formula could not anticipate a claim because the generic formula encompassed a vast number of compounds. Further support can be found in *Akzo N.V. v. International Trade Comm’n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986), wherein a claim to a specific concentration of a chemical was not anticipated by a disclosure of a general concentration of the chemical.

One of ordinary skill in the art would not envisage the utilization of the pyrazolone derivatives provided in Nishi, to treat arterial wall injury, based on a reading of Nishi. Regardless of the number of disorders that is recited in the specification, Nishi et al. does not provide for a method of preventing or treating an arterial wall injury. Therefore, at least one element of the claimed subject matter is lacking in Nishi, and Nishi does not anticipate the instant claims. Applicants respectfully request withdrawal of this rejection.

In view of the above remarks, Applicants believe the pending application is in condition for allowance. Should any of the claims not be found to be allowable, the Examiner is requested to telephone Applicants' undersigned representative at the number below. Applicants thank the Examiner in advance for this courtesy.

The Director is hereby authorized to charge or credit any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Attorney Docket No. 48185-59753, Customer No. 21874.

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Respectfully submitted,

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